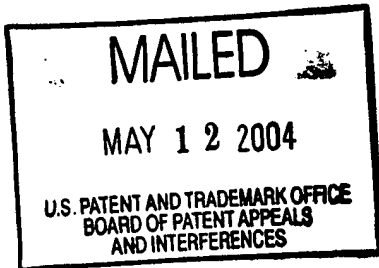


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH J. BERKE,
and CHARLES T. MICHAEL

Appeal No. 2003-0252
Application No. 09/207,634

ON BRIEF

Before COHEN, ABRAMS, and STAAB, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 5-10, 12-14 and 20-28. Claim 11, the only other claim currently pending in the application, has been allowed. On page 2 of the answer (Paper No. 18), the examiner states that "[t]he prior art rejection of claim 13 is being withdrawn." Accordingly, the appeal as to claim 13 is dismissed, leaving for our consideration only the rejections of claim 5-10, 12, 14, and 20-28.

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Appellants' invention pertains to a wheeled cart having a removable carrier for transporting a closed bag filled with loose or granular material. A further understanding of the invention can be derived from a reading of exemplary claim 5, which reads as follows:

5. In combination with a cart, a carrier mounted on an upper portion of said cart for transporting a closed bag or sack, said carrier having a pair of elongated jaws, and a means for clamping said jaws to and releasing said jaws from an upper portion of said closed bag or sack, and a handle attached to at least one of said jaws.

The references relied upon by the examiner in the final rejection are:

Smith	4,044,784	Aug. 30, 1977
Arias et al.	4,261,447	Apr. 14, 1981
Brown	5,301,393	Apr. 12, 1994
White	5,621,950	Apr. 22, 1997
Faraj	5,697,624	Dec. 16, 1997

The following rejections under 35 U.S.C. § 103(a) are before us for review:

(1) claims 5-8, 10, 20, 21 and 24-28, rejected as being unpatentable over Faraj in view of White;

(2) claim 9, rejected as being unpatentable over Faraj in view of White, and further in view of Arias;

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(3) claims 12 and 14, rejected as being unpatentable over Faraj in view of White, and further in view of Smith;

(4) claims 5-8, 10 and 20-28, rejected as being unpatentable over Faraj in view of Brown;

(5) claim 9, rejected as being unpatentable over Faraj in view of Brown, and further in view of Arias; and

(6) claims 12 and 14, rejected as being unpatentable over Faraj in view of Brown, and further in view of Smith.

Reference is made to appellants' second amended brief (Paper No. 17) and to the examiner's answer (Paper No. 18) for the respective positions of appellants and the examiner regarding the merits of these rejections.

Discussion

I. The 35 U.S.C. § 103(a) rejection of claims 5-8, 10, 20, 21 and 24-28 as being unpatentable over Faraj in view of White (rejection (1)) and claims 5-8, 10 and 20-28 as being unpatentable over Faraj in view of Brown (rejection (4))

Faraj, the examiner's primary reference in each of these rejections, is directed to a cart for transporting bags, cartons and other containers of groceries or other items from the point of purchase (abstract). The cart comprises a support member 12 having a handle 24 attached to a top end portion 14 of the support member,

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and a wheel assembly 20, which may include either a single wheel or dual wheels (column 2, lines 32-34), mounted on a bottom end portion 16 of the support member. A plurality of U-shaped or J-shaped hooks 26 are located on a middle portion 18 of the support member, and are positioned for receiving a handle or handles of a first container 28, such as a bag (column 2, lines 44-48). A bracket 30 is hingedly connected to the middle portion below the plurality of hooks 26 for supporting a second container 32, such as a carton of soft drinks or bag of pet food (column 2, lines 56-60). In addition, a storage compartment 34 is provided on the support member 12 for storing reusable bags.

As implicitly conceded by the examiner (see pages 4 and 6-7 in the answer), the cart disclosed by Faraj does not include a carrier mounted on an upper portion of the cart having a pair of elongated jaws, and a means for clamping the jaws to and releasing the jaws from an upper portion of a closed bag or sack, as called for in one form or another in each of the independent claims 5, 14, 24 and 28 on appeal. To cure this shortcoming, the examiner turns alternatively to White (rejection (1)) and Brown (rejection (4)).

White pertains to a spring-loaded paper clip having a pair of plate elements 12, 14 hingedly connected together and provided with raised projections 38 to improve gripping force so that larger

quantities of paper may be held together without shifting or slipping. An elongated member 32 having a closed loop 36 is affixed to the back of one of the plate elements to facilitate fastening the paper clip to a vertical support, such as a wall or bulletin board. Brown discloses a spring biased clip comprising a pair of clamping elements 12, 16 hingedly connected together in combination with a spring 32. The clamping elements are provided with clamping edges 18, 20 to concentrate the application of force against the sheet material being clamped together. The clip of Brown may be used as a paper clip or bag clip. When used as a bag clip, the upper edges of, for example, a snack bag that has been opened are folded over a couple of times and then the clip is applied to ensure a good air tight seal (column 3, lines 55-62).

In proposing to combine Faraj with either White or Brown to reject independent claims 5, 14, 24 and 28, the examiner concluded that it would have been obvious, based on the teachings of White or Brown, to combine the bag carrier (i.e., clip) of one or the other of the secondary references with the cart of Faraj "to facilitate ease in transporting bags without handles" (answer, pages 4 and 7).

In our view, the disparate teachings of Faraj and either White or Brown would not have suggested the combinations advanced by the examiner, which presumably involves incorporating the clip of White

or Brown into the carrier of Faraj in a manner that would permit the incorporated clip to engage and close the mouth of a bag being transported by Faraj's carrier. In particular, there would appear to be no reason, aside from the hindsight knowledge first gleaned from reading appellants' disclosure, for incorporating the clip of either White or Brown into the carrier of Faraj "to facilitate ease in transporting bags without handles" as proposed by the examiner, since Faraj provides separate and distinct schemes for handling bags with and without handles. In this regard, note column 2, lines 44-48 ("A plurality of U-shaped or J-shaped hooks 26 are located on the middle portion 18 . . . for receiving a *handle or handles* of a first container, such as a bag, and supporting the container 28" (emphasis added)) and column 2, lines 56-60 ("A bracket 30 hingedly connected to the middle portion 18 . . . is provided for supporting a second container 32, such as a . . . bag of pet food or other container *without handles*" (emphasis added)).

The mere fact that the prior art could be modified does not make such a modification obvious absent suggestion of the desirability of doing so. See, for example, *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we fail to perceive any teaching, suggestion or incentive in the applied references which would have led one of ordinary skill

in the art to modify the cart of Faraj system in the manner proposed by the examiner. It appears to us that the only suggestion for doing so is found in the hindsight accorded one who first viewed appellants' disclosure. This, of course, is not a proper basis for a rejection under 35 U.S.C. § 103. See *In re Fritch*, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 5-8, 10, 20, 21 and 24-28 as being unpatentable over Faraj in view of White (rejection (1)), or claims 5-8, 10 and 20-28 as being unpatentable over Faraj in view of Brown (rejection (4)).

II. The 35 U.S.C. § 103(a) rejections further in view of Arias or Smith (rejections (2), (3), (5) and (6))

We have carefully reviewed the Arias and Smith references additionally relied upon by the examiner in rejections (2), (3), (5) and (6), but find nothing therein that makes up for the deficiencies of Faraj and either White or Brown discussed above. Accordingly, we also shall not sustain the standing rejection of claim 9 as being unpatentable over Faraj in view of White and Arias (rejection (2)), claims 12 and 14 as being unpatentable over Faraj in view of White and Smith (rejection (3)), claim 9 as being unpatentable over Faraj in view of Brown and Arias (rejection (5)),


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and claims 12 and 14 as being unpatentable over Faraj in view of Brown and Smith (rejection (6)).

Conclusion

The decision of the examiner finally rejecting the appealed claims is reversed.

REVERSED



IRWIN CHARLES COHEN
Administrative Patent Judge



NEAL E. ABRAMS
Administrative Patent Judge

Lawrence. Stob

LAWRENCE J. STAAB
Administrative Patent Judge

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